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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,593	07/19/2000	Christian Lutz	1959/49027	5222

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/600,593

Applicant(s)

LUTZ, CHRISTIAN

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-37, 39-41, 44-46 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) 22, 24, 26, 28, 31-35, 41, 45 and 48-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 23, 25, 27, 29, 30, 36, 37, 39, 40, 44, 46 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Election/Restrictions*

2. Claims 22, 24, 26, 28, 31-35, 41, 45 & 48-55 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election of Species I (shown in Figs. 1-3) was made **without** traverse in the reply filed on May 29, 2001.

a. Claims 22, 24, 26, 28, 31-35 & 51-55 remain withdrawn as noted in the Office action mailed January 24, 2003.

b. In response to applicant's arguments in the amendment filed April 8, 2004, claims 41, 45 & 48-50 have been withdrawn because they read only on an unelected species.

See the last paragraph on page 10 and the third paragraph on page 11 of that amendment.

*Drawings*

3. Drawings have been filed in this application as follows:

Date	Contents							
	sheet	1/6	2/6	3/6	4/6	5/6	6/6	
7/19/00	figures	1, 2	3	4, 5	6, 7	8, 8a, 8b	9a, 9b, 10a, 10b	
5/29/01	sheet	1/6	2/6					
	figures	1, 2	3, 3a					

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12/4/02	sheet		2/6					new
	figures		3					3b

4. A new sheet 2/6 is required. It must include (1) a clean copy of Fig. 3 as it appears in the drawings filed 12/4/02; and (2) a clean copy of Fig. 3a as it appeared in the drawings filed 5/29/01.

In the amendment filed April 8, 2004, applicant argues that in the drawings filed on May 29, 2001, Figs. 3 & 3a were submitted on separate sheets. However, the drawings received by the Office on May 29, 2001 have Figs. 3 & 3a on a single sheet.

5. A clean copy of Fig. 3b is also required.

#### *Claim Objections*

6. Claim 44 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20.

#### *Claim Rejections - 35 USC § 101*

7. Claims 20, 21, 23, 25, 27, 29, 30, 36, 37, 39, 40, 44, 46 & 56 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Applicant has not identified a single instance where the disclosed double joint, which is a non-constant velocity joint (see item 10 of the Office action mailed June 4, 2002), would or should be used in place of a prior art non-constant velocity joint (e.g. a single Hooke's joint).

*Claim Rejections - 35 USC § 102*

8. Claims 20, 21, 23, 36, 40, 44 & 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmke, CA 604,536.

- a. Claims 20 & 44: Fig. 7 shows a double universal joint with shaft ends 20, 21 fastened against rotation in the universal joint, these ends being held for movement in a housing 29 joining two single joints 18, 19 and these ends 20, 21 being joined together between the two joints by a ball joint so that a ball 10 connected to one shaft end 20, is mounted for rotation about a center point of the ball in a socket 13 of the shaft end 21 and is slidably movable in the direction of the shaft axis of the other shaft end 21, wherein the socket 13 is resiliently pivotally mounted to the other shaft end 21.
- b. Claim 21: Fig. 7 shows a slide bushing 11 held by the socket 13, the slide bushing 11 being enveloped at least partially by the socket 13 and being disposed between the ball 10 and the socket 13.
- c. Claim 23: Fig. 7 shows that the resiliently pivotally mounting of the socket 13 in the other shaft end 21 includes metal springs.
- d. Claim 36: Fig. 7 shows on an inner wall of the housing 29 that an abutment structure 33 is provided for the ball and the socket.
- e. Claims 40 & 46: Fig. 7 shows the socket 13 is resiliently supported in the axial direction.

*Claim Rejections - 35 U.S.C. § 103*

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9. Claims 25 & 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmke in view of Bell, US 4,160,626. Helmke shows all the limitations of the claimed invention except Helmke does not expressly disclose the metal spring in the form of plate springs. In Fig. 3, Bell shows plate springs 92 and teaches in col. 4, lines 40-48, using these springs in order to provide sufficient compression. It would have been obvious to one of ordinary skill in the art to modify the double joint of Helmke by making the spring in the form of plate springs in order to provide sufficient compression as taught by Bell.

#### *Double Patenting*

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 20, 21, 23, 25, 27, 29, 30, 36, 37, 39, 40, 44, 46 & 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,692,363. In the last paragraph on page 14 of the amendment filed April 8, 2004 applicant argues that the claimed inventions of the instant application and the

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patent are similar. If by the word "similar" applicant means the inventions are patentably indistinct, then such meaning constitutes valid grounds for this rejection.

*Response to Arguments*

12. Applicant's arguments filed April 8, 2004 have been fully considered but they are not persuasive.

a. Applicant argues that the disclosed invention has patentable utility because there is nothing to prevent the disclosed invention from being used in an application that does not require constant velocity. This is true, but there are already many non-constant velocity joints in the prior art of simpler and less expensive design that are used in such applications. When applicant shows why someone would use applicant's universal joint instead of a simpler and cheaper prior art universal joint, then applicant will have provided patentable utility for his invention.

b. Applicant argues that, because of manufacturing tolerances, no prior art double universal joint is a true constant velocity joint. However, in spite of the manufacturing tolerances, prior art double universal joints are used in constant velocity applications as noted in the third full paragraph in the second column on page 100 of the *Universal Joint Design Manual*.

c. Applicant argues that his invention has patentable utility because the prior art cited in the 102 rejections of the Office action mailed January 24, 2003 have patentable utility. However, the prior art to Curtis was published in 1935 when presumably there was a need (i.e. patentable utility) for its teaching. Is applicant suggesting that the instant

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invention was developed only to meet the needs of 1930's technology? If so, that will not suffice for patentable utility in 2004. As for a Canadian patent (i.e. Helmke), the Office does not take a position on whether or not such a publication meets or lacks patentable utility. Thus Helmke cannot be relied upon in the manner argued by applicant.

d. Applicant argues that the disclosed invention has patentable utility because it is similar to a double universal joint disclosed in an allowed patent application. If applicant is stipulating that there is no patentable difference between the claims in the instant application and those of the allowed application, then the 101 rejection above is overcome. If not, the rejection remains because the utility for a patented invention does not in and of itself suggest there is utility for another, patentably distinct, invention.

e. Applicant argues that Helmke fails to show the claimed invention because Helmke fails to show a double joint. However, as noted in the rejection above, Helmke shows two single joints 18 & 19 that are joined together to form a double joint.

f. Applicant argues that Helmke fails to show the sphere 10 as able to slide in the direction of the axis of the shaft 21. However, Fig. 7 shows the sphere 10 is biased in the axial direction by the spring piston in the end of the shaft 21. Therefore the sphere could move in the axial direction against this bias and such movement would be purely along the axis of the shaft 21 when the shafts 21 & 20 are aligned.



*Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

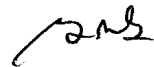
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda  
Primary Examiner  
Art Unit 3679